II. REMARKS:

A. Status of the Claims

Claim 1 was originally filed with the case. Claim 1 is amended and Claims 2-6 are added herein. Support for the amendments to claim 1 can be found at page 4, lines 33-36 and at page 6, lines 4-13. Support for the added claims can be found at page 4, lines 33-36 and page 6, lines 21-26. Therefore, claims 1-6 are currently pending.

B. The Claims are Enabled

The Action rejects claim 1 as lacking enablement for the scope of the claim. According to the Action, the specification does not provide enablement for any angiogenic/edematous disorder or all PDE IV inhibitors. Applicants respectfully traverse. Nevertheless, in order to progress the case toward allowance, Applicants have amended the claims to specify the angiogenic disorders and to list preferred PDE IV inhibitors in claim 1. Applicants reserve the right to pursue additional subject matter disclosed in the specification in properly filed continuation applications. It is believed that the amendments to claim 1 render the enablement rejection moot. Therefore, Applicants respectfully request that the enablement rejection be withdrawn.

C. The Claims are Not Anticipated

The Action next rejects claim 1 as being anticipated by Man and Muller (WO 01/34606). Man is said to teach isoindoline compounds useful as PDE IV inhibitors for the treatment of angiogenesis. Applicants respectfully traverse.

The present invention is directed to methods of treating posterior segment neovascularization, such as age-related macular degeneration and diabetic retinopathy, by administering a PDE IV inhibiting compound selected from 2-(4-ethoxycarbonylaminobenzyl)-6-(3,4-dimethoxyphenyl)-2,3,4,5-tetrahydro-pyridazin-3-one, 3-[3-(cyclopentyloxy)-4-methoxybenzyl]-6-(ethylamino)-8-isopropyl-3H-purine hydrochloride (V-11294A), 8-methoxyquinoline-5-[N-(2,5-dichloropyridin-3-yl)]carboxamide (D-4418), cipamfylline (BRL-61063), ariflo (SB-207499), and derivatives thereof. Man appears to provide a discussion of isoindoline derivatives, in general. According to Man, the compounds disclosed therein "inhibit angiogenesis and are useful in the treatment of cancer, inflammatory, and autoimmune diseases" (page 1, lines 9-11). Although Man does mention that unregulated angiogenesis sustains progression of "some types of eye disorders," and that maintenance of the avascularity of the cornea, lens, and trabecular meshwork is crucial for vision, it does not specifically mention posterior segment neovascularization, age-related macular degeneration, diabetic retinopathy, or any of the specific PDE IV inhibitors listed in the claims.

For a prior art reference to render a claim anticipated, that reference must set forth every element in the claim, either expressly or inherently. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983)). In other words, to support a rejection under section 102, a reference must show ***all*** features of the rejected claim(s). *Minnesota Mining & Mfg. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1569, 24 USPQ2d 1321 (Fed. Cir. 1992). The Federal Circuit has stated that "absence of

a claim element from a prior art reference negates anticipation." *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 U.S.P.Q. 409 (Fed. Cir. 1984).

Since Man lacks any teaching of the treatment of posterior segment neovascularization, age-related macular degeneration or diabetic retinopathy or of the use of any compounds listed in the presently pending claims for the treatment of those disorders, it is believed that Man cannot anticipate the claimed invention.

In light of the foregoing arguments, it is respectfully requested that the anticipation rejection based on Man be withdrawn.

D. Conclusion

This is submitted to be a complete response to the outstanding Action. Based on the foregoing arguments, the claims are believed to be in condition for allowance; a notice of allowability is therefore respectfully requested.

The Examiner is invited to contact the undersigned attorney at (817) 551-4321 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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